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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,142	06/20/2003	Jean-Pierre Sommadossi	06171.IDX 1007 CON2	8280
57263 7590 03/29/2007 KING & SPALDING LLP 1180 PEACHTREE STREET ATLANTA, GA 30309			EXAMINER MCINTOSH III, TRAVISS C	
			ART UNIT	PAPER NUMBER
			1623	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/29/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/602,142

Applicant(s)

SOMMADOSSI ET AL.

Examiner

Traviss C. McIntosh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89 and 130-177 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 89 and 130-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment filed 1/3/2007 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

No claims have been amended.

No claims have been added.

No claims have been canceled.

Remarks drawn to rejections of Office Action mailed 7/28/2006 include:

112 1st paragraph written description rejection: which has been overcome by applicant's arguments and showing of support for the pyrrolopyrimidine base on page 53 of the specification and has been withdrawn.

102(b) rejection: which has been overcome by applicant's arguments and showing of support for the pyrrolopyrimidine base in the priority document and has been withdrawn.

103(a) rejection: which has been overcome by applicant's arguments and showing of support for the pyrrolopyrimidine base in the priority document and has been withdrawn.

An action on the merits of claims 89 and 130-177 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

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improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 89 and 130-177 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-31 of U.S. Patent No. 7,163,929. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim methods of treating HCV using pyrrolopyrimidine nucleosides, and alternately in combination with the same additional anti-viral agents. It is noted that the ‘929 patent is drawn to treating flavivirus or pestivirus infections, however, HCV is known to be a flavivirus, as such is encompassed by the ‘929 patent. It would be obvious to one of ordinary skill in the art that the instant application and the ‘929 patent are substantially overlapping.

Claims 89 and 130-177 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2-17 and 19-75 of copending Application No. 11/005,472. Although the conflicting claims are not identical, they

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are not patentably distinct from each other because both applications claim methods of treating HCV using pyrrolopyrimidine nucleosides, and alternately in combination with the same additional anti-viral agents. It is noted that the '472 application is drawn to treating flavivirus infections, however, HCV is known to be a flavivirus as evidenced by claim 3 of the '472 application, as such is encompassed by the '472 application. It would be obvious to one of ordinary skill in the art that the instant application and the '472 application are substantially overlapping.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 89 and 131-177 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 89 R¹ and R² are defined as optionally being "benzyl, wherein the phenyl group is optionally substituted with one or more substituents;" In the absence of the identity of moieties which are intended to be substituted (the substituents), thus modifying an art recognized chemical core, described structurally or by chemical name, the identity of "substituted" would be difficult to ascertain. In the absence of said moieties, the claims containing the term "substituted" are not described sufficiently to distinctly point out that which applicant intends as the invention.

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All claims that include the limitation of "substituted" without clearly indicating the moieties which are intended to be substituted, are indefinite.

Regarding claim 152, the phrase "substantially pure" renders the claim indefinite because the phrase is seen to be a relative term. As such, one would not be able to know the metes and bounds of the claim, as one would not know to what level of pureness is intended. See MPEP § 2173.05.

All claims which depend from an indefinite claim are also indefinite. *Ex parte Cordova, 10 U.S.P.Q. 2d 1949, 1952 (P.T.O. Bd. App. 1989).*

Conclusion

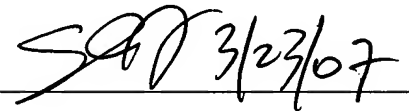
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Traviss C. McIntosh whose telephone number is 571-272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss McIntosh
March 19, 2007

Shaojia A. Jiang
Supervisory patent Examiner
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 3/23/07